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10/036,861	12/21/2001	Michael George Gorman	8285/490	4336

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EXAMINER

HARPER, KEVIN C

ART UNIT PAPER NUMBER

2666

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/036,861

Applicant(s)

GORMAN ET AL.

Examiner

Kevin C. Harper

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 48,53 and 65-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48,53 and 65-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 48, 53 and 74-77 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,370,149 in view of Whittaker et al. (US, 6130,893) and Rydberg et al. (US 6,360,257).

1. Regarding claims 48 and 74-77, claim 1 of the '149 patent recites the claimed limitations except a plurality of derived digital telephone lines. Whittaker discloses derived digital telephone lines (col. 1, lines 28-37). Regarding claim 77, the interface has a processor (fig. 3, items 52 and 68) for executing software (col. 3, lines 25-30 and 58-64; note: Ethernet protocol). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to recite a plurality of derived digital telephone lines in the '149 patent in order to allow the use of several analog telephones over a DSL connection (Whittaker, col. 3, lines 31-35).

2. Further, claim 1 of the '149 patent additionally recites that the analog telephone in combination with the subscriber interface is capable of accessing and monitoring the plurality of derived digital telephone lines. In removing functionality, the scope of the claim is merely broadened. It has been held that omission of an element and its function is an obvious expedient

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if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 365 (Bd. App. 1969) (omission of a reference element whose function is not needed would be obvious to one skilled in the art). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to remove the additional functionality of the subscriber interface.

3. Further, Claim 1 of the '149 patent does not recite a smart card interface in the housing for receiving a smart card defining an address for the subscriber unit. Rydberg discloses a smart card interface for defining IP addresses for a subscriber device (fig. 4; col. 2, lines 13-15).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to recite assigning IP addresses on a smart card in the '149 patent in order to provide a flexibly assigned addresses to customers (Rydberg, col. 2, lines 1-5).

4. Regarding claim 53, claim 5 of the '149 patent recites the claimed limitations.

Claim 65 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,370,149 in view of Whittaker and Rydberg as applied to claim 48 above, and further in view of Musa (US 6,016,349).

5. Regarding claim 65, claim 1 of the '149 patent does not recite a PCMCIA smart card. Musa discloses a PCMCIA smart card (col. 2, lines 28-30; col. 2, line 10). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to recite a PCMCIA smart card in the '149 patent in order to comply with a well know card standard.

Claims 66-67 and 78-79 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,370,149 in

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view of Whittaker and Rydberg as applied to claim 48 or 77 above, and further in view of Dancs et al. (US 6,385,651).

6. Regarding claims 66-67 and 78-79, claim 1 of the '149 patent does not recite registering a user with the telecommunication system. Dancs discloses registering a user on a system based on information stored on a smart card (fig. 1, fig. 3, step 1006) in response to a user action (fig. 3, item 1002). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to recite registering a user in the '149 patent in order to provide centralized access control within the network (Dancs, col. 1, line 66 through col. 2, line 5).

Claims 68-70 and 80-82 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,370,149 in view of Whittaker and Rydberg as applied to claim 48 or 77 above, and further in view of Mankovitz (US 5,703,795).

7. Regarding claims 68-70 and 80-82, claim 1 of the '149 patent does not recite a smart card button. Mankovitz discloses a smart card button (col. 7, lines 51-58) for initiating commands defined by data received from a smart card (fig. 5A, steps 402-403). The information also includes a speed dial list (col. 12, line 65 through col. 13, line 4; fig. 6). Therefore it would have been obvious to one skilled in the art at the time the invention was made to recite a smart card button on the subscriber unit in the '149 patent in order to receive previously stored data from a remote device (Mankovitz, col. 7, lines 11-20).

Claims 71-73 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,370,149 in view

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of Whittaker and Rydberg as applied to claim 48 above, and further in view of Harrington (US 5,546,454).

8. Regarding claims 71-72, claim 1 of the '149 patent does not recite an alphanumeric display. Harrington discloses an alphanumeric display for a telephony device (fig. 2, items 38 and 46) relating to a selected outgoing line (fig. 3B; col. 4, lines 38-50). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to recite a display in the '149 patent in order to provide a visual indicator for a telephony device (col. 4, line 65 through col. 5, line 15).

9. Regarding claims 73, claim 1 of the '149 patent does not recite displaying caller ID. Examiner takes Official Notice that caller ID information is displayed on a telephony device. Therefore, it would have been obvious to recite displaying caller ID information on a telephony device in the '149 patent so that a user is made aware of the telephone number of the incoming call.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 48, 53 and 74-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whittaker et al. (US 6,130,893) in view of Johnson (US 5,999,801) and Rydberg et al. (US 6,360,257).

10. Regarding claims 48 and 74-77, Whittaker discloses a subscriber interface (fig. 1, item 20; fig. 31 col. 3, lines 31-35) for use in a telecommunications system (fig. 1, item 16; fig. 2; col.

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3, lines 17-25) including a digital switch (fig. 2, item 92), a local loop (fig. 1, item 12) coupling the digital switch to a subscriber location, where a segment of the local loop includes a copper twisted pair carrying ADSL (col. 3, lines 6-10), where the ADSL has several derived digital telephone lines (col. 1, lines 29-31), and the subscriber interface couples the ADSL to an analog telephone (fig. 1, item 30). The subscriber interface comprises an inherent housing (fig. 3), an electric coupler for connection to a cable carrying the ADSL (item 47; col. 3, lines 10-11; note: the jack 47 is connected to the LAN which is connected to the ADSL modem), a telephone jack (item 48; col. 4, lines 53-54), and a converter (fig. 3, items 58 and 66) coupled to the electrical coupler and the telephone jack, for converting the first analog signals generated by the analog telephone into a first plurality of data packets for transmission to a selected one of the derived digital telephone lines (col. 1, lines 29-31; col. 5, lines 5-15) and for converting a second plurality of data packets received from the selected one of the derived digital telephone lines into a second analog signal for transmission to the analog phone (col. 4, lines 43-55 and line 60 through col. 5, line 2). Regarding claims 77, the interface has a processor (fig. 3, items 52 and 68) for executing software (col. 3, lines 25-30 and 58-64; note: Ethernet protocol).

11. However, Whittaker does not disclose that the housing has a top surface and a bottom surface that are substantially coplanar. Johnson discloses an electrical device having a housing with co-planar top and bottom surfaces (fig. 1, item 10). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have co-planar top and bottom surfaces for the subscriber interface in the invention of Whittaker in order to provide a simple box design for construction and manufacturing.

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12. Further, Whittaker in view of Johnson does not disclose a smart card interface in the housing for receiving a smart card defining an address for the subscriber unit. Rydberg discloses a smart card interface for defining IP addresses for a subscriber device (fig. 4; col. 2, lines 13-15). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to assign IP addresses on a smart card in the invention of Whittaker in view of Johnson in order to provide a flexibly assigned addresses to customers (Rydberg, col. 2, lines 1-5).

13. Regarding claim 53, in Whittaker the ADSL includes a data channel for carrying data signals not related to the derived digital telephone lines (col. 2, lines 56-66; col. 3, lines 10-12).

Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whittaker in view of Johnson and Rydberg as applied to claim 48 above, and further in view of Musa (US 6,016,349).

14. Regarding claim 65, claim 1 of the '149 patent does not recite a PCMCIA smart card. Musa discloses a PCMCIA smart card (col. 2, lines 28-30; col. 2, line 10). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to recite a PCMCIA smart card in the '149 patent in order to comply with a well know card standard.

Claims 66-67 and 78-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whittaker in view of Johnson and Rydberg as applied to claim 48 or 77 above, and further in view of Dancs et al. (US 6,385,651).

15. Regarding claims 66-67 and 78-79, Whittaker in view of Johnson and Rydberg discloses downloading an address from a smart cart in a DSL system. However, the references do not disclose registering a user with the telecommunication system. Dancs discloses registering a user on a system based on information stored on a smart card (fig. 1, fig. 3, step 1006) in



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response to a user action (fig. 3, item 1002). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to register a user in the invention of Whittaker in view of Johnson and Rydberg in order to provide centralized access control within the network (Dancs, col. 1, line 66 through col. 2, line 5).

Claim 68-70 and 80-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whittaker in view of Johnson and Rydberg as applied to claim 48 or 77 above, and further in view of Mankovitz (US 5,703,795).

16. Regarding claims 68-70 and 80-82, Whittaker in view of Johnson and Rydberg does not disclose a smart card button. Mankovitz discloses a smart card button (col. 7, lines 51-58) for initiating commands defined by data received from a smart card (fig. 5A, steps 402-403). The information also includes a speed dial list (col. 12, line 65 through col. 13, line 4; fig. 6).

Therefore it would have been obvious to one skilled in the art at the time the invention was made to have a smart card button on the subscriber unit in the invention of Whittaker in view of Johnson and Rydberg in order to receive previously stored data from a remote device (Mankovitz, col. 7, lines 11-20).

Claim 71-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whittaker in view of Johnson and Rydberg as applied to claim 48 above, and further in view of Harrington (US 5,546,454).

17. Regarding claim 71-72, Whittaker in view of Johnson and Rydberg does not disclose an alphanumeric display. Harrington discloses an alphanumeric display for a telephony device (fig. 2, items 38 and 46) relating to a selected outgoing line (fig. 3B; col. 4, lines 38-50). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have a

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display in the invention of Whittaker in view of Johnson and Rydberg in order to provide a visual indicator for a telephony device (col. 4, line 65 through col. 5, line 15).

18. Regarding claims 73, the references do not disclose displaying caller ID. Examiner takes Official Notice that caller ID information is displayed on a telephony device. Therefore, it would have been obvious to display caller ID information on a telephony device so that a user is aware of the telephone number of the incoming call.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Harper whose telephone number is 571-272-3166. The examiner can normally be reached weekdays from 11:30 AM to 7:00 PM ET.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao, can be reached at 571-272-3174. The centralized fax number for the Patent Office is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications associated with a customer number is available through Private PAIR only. For more information about the PAIR system, see [portal.uspto.gov](http://portal.uspto.gov). Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin C. Harper

October 15, 2005

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